

### REMARKS/ARGUMENTS

This amendment is submitted in response to the Office Action dated March 13, 2003. After entry of this amendment, claims 1-27, 30, 33-41, 43 and 44 will continue to be pending in the application. Reconsideration and allowance is respectfully requested in view of the remarks made below.

#### **1. *The Formal Issues***

The Abstract of the Disclosure was objected to in the Office Action because of the inclusion of the legal phraseology "said." In response to this objection, Applicant has amended the Abstract accordingly.

The drawings were objected to in the Office Action because of the inclusion of written descriptive matter. In response to the Objection, Applicant has submitted Formal Drawings that are devoid of such written descriptive matter.

Withdrawal of the formal Objections is respectfully solicited.

#### **2. *The §112 Second Paragraph Rejections***

Claims 33 and 34 were rejected under Section 112, second paragraph, for the reason that those claims were said to lack any recitation of structure of the suction cups which would permit them to have a force of adhesion that is within the specified range of force. In reviewing the claims, the undersigned simply does not understand the basis for requiring such a recitation. Section 112, second paragraph has to do with the clarity and definiteness of the claim language. It is not seen how a recitation of the structure that is required to give a suction cup a certain force of adhesion is required to give the claim the requisite clarity and definiteness required by the statute. Accordingly, Applicant respectfully requests withdrawal of this basis for rejection.

#### **3. *The Prior Art Rejections***

Original claims 1, 2, 9-18, 27, and 41-44 were rejected in the Office Action has been anticipated by U. S. Patent 5,226,467 to Lii ("Lii"). Original claims 23-26 were rejected as

being clearly anticipated by U. S. Patent 5,330,251 to McGuire ("McGuire"). Original claims 3-8 were rejected under Section 103 based on a proposed combination of Lii and McGuire. Original claims 19-22 and 28-40 were rejected under Section 103 based on a proposed combination of Lii and U. S. Patent 4,823,859 to Park ("Park"). Applicant respectfully traverses these rejections and respectfully submits that it would be inappropriate to apply such rejections to those claims that have been amended, for the reasons set forth below.

Applicant's independent claim one clearly recites the requirement of an arresting mechanism that is constructed and arranged so as to permit the drum member to be stopped when the shade element is in the second extended position and in any of a plurality of predetermined intermediate positions that are between the first, fully retracted position and the second, extended position. Most significantly, independent claim one further requires the arresting mechanism to include controlled retraction structure for permitting a consumer to partially retract the shade element by a controlled predetermined distance. For example, in Applicant's preferred embodiment the controlled retraction structure permits the consumer to cause retraction of the shade element by a distance that is equal to exactly one rotation of the drum element by depressing a button by a first amount. The retraction structure prevents retraction of the sunshade by any distance in excess of this predetermined amount of retraction. In other words, when controlled retraction is desired the controlled retraction structure prevents retraction from occurring that is more or less than the predetermined amount.

This feature of Applicants invention is not taught or suggested in any of the references of record, including the Lii reference. Lii discloses a retraction mechanism in which a user is required to linearly slide a control element in order to retract the windshield blind. It permits partial retraction of the windshield blind, but not by a controlled predetermined distance as is set forth in independent claim one. To cause partial retraction in Lii a consumer would have to slide the control element in one direction and then quickly reverse it back to the neutral position. The amount of retraction that would occur would depend upon how quickly the action was performed. In other words, the degree of retraction that would occur is not controlled, but almost infinitely variable.

For these reasons, reconsideration and withdrawal of the rejections that were applied to independent claim one are respectfully requested.

Applicant has amended independent claim 23 two more specifically set forth the structure that makes the assembly recited in the claim a vehicle sunshade. McGuire relates to a retractable seat cover apparatus that is structurally and functionally completely different than the vehicle sunshade that Applicant is setting forth in amended independent claim 23. Certainly, the concept of marker elements being movable on a surface per se is well known, as any owner of a checkerboard could verify. Yes, this concept is taught in McGuire. Applicants invention, however, has to do with the concept of a marker element that is affixable to a shade element of a vehicle sunshade. To take the position that it would have been obvious to a person having ordinary skill in the art at the time Applicants invention was made to substitute this well-known concept into the specific application of a vehicle sunshade ignores the requirement that some suggestion or incentive must be demonstrated to support a Section 103 obviousness rejection. Applicant respectfully submits that there is no suggestion or incentive demonstrated that would have motivated the hypothetical person of ordinary skill to modify existing sunshades in order to equip them with removable marker elements as claim 23 requires. Accordingly, withdrawal of the Section 103 rejection of independent claim 23 and the claims depending therefrom is respectfully requested.

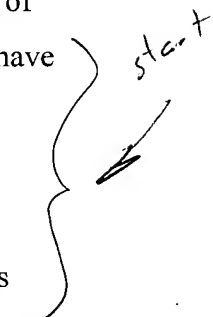
*same  
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Independent claim 27 recites a sunshade for a vehicle in which the housing is shaped and sized so as to preclude a person from being able to touch a portion of the shade element that is wrapped about the drum member. Most advantageously, this will reduce the possibility of the persons fingers being pinched, which is particularly helpful for the caregivers of small children. The undersigned has carefully reviewed the references of record and fails to note the disclosure or suggestion of any sunshade having a housing that is shaped and sized so as to preclude a person from being able to touch a portion of the shade element that is wrapped about the supporting drum member. In the case of the Lii reference, the housing that is indicated by reference numeral 8 only extends for a small fraction around the circumference of the support drum. In fact, it is referred to in the specification of the reference as a curved cap. Because it leaves most of the circumference of the drum and the sunshade wrapped about the drum uncovered, a person would clearly be able to touch a portion of the shade element that is wrapped about the drum member. Accordingly, this reference does not anticipate independent claim 27. Moreover, there is no disclosure or suggestion that would provide any incentive for

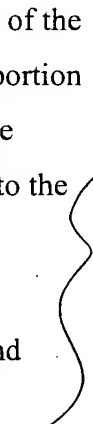
the person having ordinary skill to modify the structure disclosed in the reference in order to provide a housing that does preclude a person from being able to touch a portion of the shade element that is wrapped about the drum member. Accordingly, independent claim 27 patently defines over the prior art of record. Withdrawal of the rejection to independent claim 27 is respectfully requested for that reason.

Independent claim 30 has been amended to specifically recite that the gripping member is shaped so as to provide a lever arm of sufficient length in a direction that is perpendicular to a common axis defined by the location of the suction cups to permit a consumer to conveniently disengage the suction cups from a vehicle window. The length is specifically defined as being within a range of about 0.4 in. to about 2.5 in.

This concept is not disclosed or suggested in any of the references of record. The Park reference discloses a windshield protective device in which the suction cups of the distal end of the sunshade are mounted together by a long, narrow strip. This long, narrow strip does not have sufficient width to permit a consumer to conveniently disengage the suction cups from the vehicle window. It certainly does not disclose or suggest a width that is sufficient to create a lever arm that is within a range of about 0.4 in. to about 2.5 in. as is set forth in claim 30. Accordingly, an indication of allowability for claim 30 and the claims depending therefrom is respectfully solicited.

A handwritten bracket on the right side of the text, spanning from the sentence "This concept is not disclosed or suggested in any of the references of record." down to "Accordingly, an indication of allowability for claim 30 and the claims depending therefrom is respectfully solicited." An arrow points from the bracket to the word "start" written above it.

Independent claim 38 recites a sunshade for a vehicle in which the gripping member and the second mounting means are constructed and arranged so as to facilitate disengagement of the second mounting means from the second portion of the vehicle window when the second portion of the vehicle window is attempted to be lowered into the vehicle door. The Park reference clearly does not disclose or suggest this concept, because its vehicle sunshade is mounted to the windshield of the vehicle, not one of the windows that can be raised or lowered. The Lii reference provides only very sparse disclosure about how the distal end of the sunshade is secured to the vehicle window. It clearly does not disclose a gripping member and a second mounting means having the function that is clearly set forth in independent claim 38. Accordingly, withdrawal of the rejection of claim 38 and the claims depending therefrom is respectfully solicited.

A large handwritten bracket on the right side of the text, spanning from the sentence "Independent claim 38 recites a sunshade for a vehicle in which the gripping member and the second mounting means are constructed and arranged so as to facilitate disengagement of the second mounting means from the second portion of the vehicle window when the second portion of the vehicle window is attempted to be lowered into the vehicle door." down to "Accordingly, withdrawal of the rejection of claim 38 and the claims depending therefrom is respectfully solicited."

Independent claim 41 has been amended to recite a retraction mechanism for enabling a consumer by depressing a control element using just one hand to move the shade element to anyone of a plurality of different predetermined index positions. This concept is clearly not taught in the Lii reference, where retraction of the sunshade is initiated by sliding a control element, not depressing a control element as is set forth in claim 41. There is a fundamental operable difference between the sliding motion disclosed in the reference and the depressing motion that is set forth in claim 41. Depressing a control element can be accomplished by using one hand, while simultaneously sliding a control element and bracing the rest of the apparatus can only be accomplished by using both hands. Accordingly, the sunshade that is set forth in claim 41 is structurally different from that set forth in the reference, with clear functional advantages associated with the structural difference. There is no disclosure or suggestion in the reference or elsewhere in the prior art that would have led a person having ordinary skill to contemplate modifying the sliding control element that is disclosed in the reference to a depressive control element as is set forth in claim 41. Accordingly, claim 41 and the claims depending therefrom patently define over the prior art of record, and the rejection should be withdrawn.

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4. *Conclusion*

Applicant has made an earnest effort to place this application in condition for allowance. If the Examiner feels that a telephone interview would expedite prosecution of this patent application, he is respectfully invited to telephone the undersigned at 215-599-0600.

Respectfully submitted,

Date: 8/1/03

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